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**OCT 27 2008**

**OFFICE OF PETITIONS**

In re Application of	:	
Wheeler et al.	:	
Application No. 10/020541	:	DECISION
Filing or 371(c) Date: 04/26/2002	:	ON PETITION
Attorney Docket Number:	:	
17400(BAR)	:	

This is a decision on the "Petition Pursuant to 37 CFR 1.182 for Reinstatement of Priority Date," filed January 8, 2008. The petition is properly treated under 37 CFR 1.181<sup>1</sup>.

This Petition is hereby **dismissed**.

Application papers were filed in the above-identified application on October 30, 2001. However, on March 26, 2002, the Office of Initial Patent Examination mailed a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (hereinafter "Notice"), which also notified Applicant's that page 14 of the specification appeared to have been omitted from the application.

The Notice provided Applicant with the following three options:

I. Should Applicant contend that the omitted item was in fact deposited in this Office with the application papers, Applicant was required to file a petition, along with evidence of the deposit.

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<sup>1</sup> A petition under 37 CFR § 1.182 is the appropriate venue where the issue is not otherwise specifically provided for in the rules of practice. Here, the petition is filed to reinstate the filing date of the application that was changed in the Decision on Petition mailed August 14, 2002. As such, the appropriate venue is 37 CFR 1.181, Petitions to the Director, which provides the forum for petitioning from any action in the ex-parte prosecution of an application which is not subject to appeal to the Board or to the court, and to invoke the supervisory authority of the Director. Since there is a specific mechanism in place to remedy the requested relief, then it is inappropriate for the USPTO to contemplate circumventing that mechanism by creating another remedy, in this instance, under 37 CFR 1.182.

II. Should Applicant desire to supply the omitted item(s) and accept the date that such omitted item was filed in this Office as the filing date of the application, a copy of the Notice; the omitted item; a supplemental oath/declaration and a petition were required.

III. Applicant could also not file a petition and accept the application as deposited, and maintain the filing date accorded the application without the omitted page.

The April 26, 2002 Petition

In response to the Notice, Applicant submitted a petition on April 26, 2002, a copy of the Notice, and a Supplemental Declaration, which made reference to page 14 of the specification. The petition acknowledged that page 14 of the specification was inadvertently omitted from the originally-filed application papers. Applicant requested entry of page 14 of the specification, and requested that page 14 of the specification be given the filing date of the petition.

The August 14, 2002 Decision on petition

A Decision on the petition was mailed August 14, 2002. The Decision noted that the mailing of the Notice permitted Applicant to either (1) promptly establish receipt in the PTO of the papers at issue, or (2) promptly submit the omitted page in a nonprovisional application and accept the date of such submission as the application filing date. The Decision stated that "Petitioner has selected option two. Accordingly, the filing date of the application is the date that page 14 of the specification was submitted, April 26, 2002." Decision at p.1.

The present petition

Applicant files the present petition to reinstate the priority date of the present specification, with the exception of page 14, or in the alternative, Applicant requests that page 14 of the specification be removed from the present specification and the remaining pages of the specification be given the benefit of priority date, November 1, 2000.

In support of this request, Applicant asserts that in the petition filed April 26, 2002, Applicant's requested that only page 14 be given the filing date of the Petition (April 26, 2002). Applicant's assert that while the Decision stated that the petition granted, the petition was not granted insofar as Applicant's never agreed to abandon the original filing date or the priority claim.

Alternatively, Applicant requests that it be allowed to delete page 14 from the specification and restore the priority (filing) date of the application to October 30, 2008.

Applicable Law, Rules and/or MPEP

35 U.S.C. § 111, Application, states:

The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

## 35 U.S.C. § 112 Specification, states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

## 37 CFR 1.53, Application number, filing date, and completion of application, states:

(b) Application filing requirements - Nonprovisional application . The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date.

## 37 CFR 1.181, Petition to the Director, states:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title. (Emphasis supplied).

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

Analysis

In the petition filed April 26, 2002, Applicant requested entry of page 14 of the specification, and requested that page 14 of the specification be given the filing date of the petition. Under the patent statute and rules of practice, page 14 did not meet the requirements for receiving a filing

date. See, 35 U.S.C. 112. Moreover, the Notice provided Applicant with the options of either (1) promptly establish receipt in the PTO of the papers at issue; (2) promptly submit the omitted page in a nonprovisional application and accept the date of such submission as the application filing date (which also required Applicant to submit a copy of the Notice and a supplemental oath/declaration), or (3) do nothing and accept the application as filed without page 14 of the specification.

Applicant responded by submitting page 14 of the specification, along with a copy of the Notice and a Supplemental oath/declaration referring to page 14 of the specification.

The decision on petition mailed August 14, 2002, clearly stated that "Petitioner has selected option two. Accordingly, the filing date of the application is the date that page 14 of the specification was submitted, April 26, 2002." Decision at p.1.

Finally, on myriad occasions throughout prosecution, Applicant acknowledged that the filing date of the application is April 26, 2002.

#### Conclusion

The decision on petition establishing the filing date was mailed August 14, 2002, and no objection having been received within two (2) months of the mail date of that decision, the present petition requesting review of that decision is dismissed as untimely.

Telephone inquiries concerning this Decision should be directed to Attorney Derek Woods at (571) 272-3232.



Anthony Knight  
Supervisor  
Office of Petitions